

REMARKS

Claims 1-5 and 10-25 are pending in this application. All claims were rejected in the Supplemental Office Action dated August 2, 2004. Claims 1-5 were rejected under 35 USC 103(a) as being unpatentable over Biddle (U.S. Patent Application Pub. No. 2002/0107809 A1) in view of Hayes (U.S. Patent Application Pub. No. 2001/0011341). Claims 10-25 were rejected under 35 USC 102(e) as anticipated by Biddle. Certain claims were discussed in a phone interview on November 2, 2004. Claims 1, 2, 3, 5, 10-12, 15 and 18 are amended. Claim 26 is added. Reconsideration of all the pending claims is requested in light of the arguments presented below.

Summary of Interview

In a phone interview between Examiner Firmin Backer, Assignee representative Dan Eaton and the undersigned attorney, the rejection of claims 1 and 18 were discussed. In particular, the “licensing module” element of claim 1 was discussed with respect to paragraph 0013 of Hayes. This portion of Hayes was cited as showing the licensing module element of claim 1 in the Office Action. It was pointed out that Hayes states, “the server stores a plurality of user applications for downloading to user stations and further stores access permissions for the applications for each user,” paragraph 0013, lines 3-5. This appears to indicate that a server controls access to applications. In contrast, the licensing module means of claim 1 was “for giving each said customer terminal computer permission to download a program module to said customer terminal computer, said licensing module means comprising an executable software application being executed on each customer terminal computer.” The Examiner indicated that the use of the term “comprising” in this context allowed the possibility that the licensing module could include a portion that runs on a server and controls access to applications. Claim 1 is amended to replace “comprising” by “consisting of” in order to clarify that the licensing module does not have any additional parts. The meaning of the term “consisting of” is believed to exclude any element other than that recited. See MPEP 2111.03. The

Examiner indicated that claim 1 would be reconsidered if limited in this way. Such reconsideration is hereby requested.

Claim 18 was discussed with respect to Biddle. In particular, the “software application” of Biddle, paragraph 0054, was identified as corresponding to the licensing module of claim 18 and the “license” of Biddle, paragraph 0054, was identified as corresponding to the program module of claim 18.

Additional arguments

Claim 1 as amended is submitted to be allowable over the cited prior art on the basis stated above and discussed in the phone interview. That is, Hayes does not appear to show a licensing module according to claim 1. In addition, claim 1 is amended to remove “means” language in order to clarify the claim meaning.

In addition to the argument discussed in the phone interview, it is submitted that no adequate motivation to combine the teachings of Hayes and Biddle was provided in the Office Action. The Office Action stated that it would have been obvious to modify the teachings of Biddle to include the teachings of Hayes, “because this would have ensure [sic] greater security of the system.” However, the Office Action did not indicate where this motivation was taught in the prior art. It is not clear how such a modification would ensure greater security than that already provided in Biddle. A *prima facie* case of obviousness requires “some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings,” MPEP 2142. It is requested that the source of the motivation to combine these references be identified. In particular, it is requested that the portion of text in a reference that suggests this combination, or the particular knowledge of one of skill in the art be identified. Because such motivation has not been identified, it is submitted that a *prima facie* case of obviousness has not been made.

Claims 2-5 are submitted to be allowable as depending from an allowable base claim. In addition, claims 2-5 recite claim limitations that do not appear to be shown by the cited prior art. Therefore, claims 2-5 are submitted to be additionally allowable over the cited prior art. Claims 2-5 are amended to remove “means” language as in claim 1.

Claim 2 includes the feature that “said e-commerce server computer and said program module server computer being distinct from one another.” These separate computers do not appear to be disclosed in the reference cited by the Office Action (fig 1, page 5 paragraphs 0053, 0054 of Biddle). With respect to Figure 1, Biddle refers to “downloading of software from a distributor computer 25 to a user computer 30 and a licensing model is executed through secure, online transactions between distributor 25 and the user 30,” paragraph 0049. Thus, it appears that both the software and licensing are handled by distributor computer 25. Biddle further states, “the vendor 40 does not have to be connected to the internet,” paragraph 0053. This appears to indicate that both software and license are available without vendor 40. Biddle also discloses, “a vendor can also assume the role of distributor 25 by purchasing a licensing system from a distributor 25 and carrying out the function of distributing software products directly,” paragraph 0053. In this example, the vendor has a “licensing system” and also distributes software products. There appears to be no disclosure of having distinct e-commerce server and program module server as in claim 2. Therefore, it is requested that the rejection be withdrawn.

Claim 5 is amended to clarify the claim language. Claim 5 as amended includes the limitation, “said program module is responsive to output from said licensing module, said program module and said licensing module each comprising executable software applications.” No such executable software applications appear to be shown in the cited portion of Biddle (Figure 1 and paragraphs 0056-0057). Instead, the cited portions of text appear to refer to installing software on a vendor system. This software does not appear to correspond to the licensing module of claim 5 because it is not “executed on each said customer terminal computer.” There appears to be no description in the cited portion of how the license of Biddle interacts with the software.

Claims 10-25 were rejected under 35 § USC 102 as anticipated by Biddle. Claim 10 is amended to include limitations previously recited in claims 13 and 14 and remove “means” language. Claim 10 as amended recites, “said distribution of one said program module is responsive to the prior execution of one said licensing module on one said customer terminal computer.” This limitation was not previously identified in the prior art references. The Office Action identified “licensing server 82” as distributing license

modules and identified “software” as program modules of claim 10. However, Biddle discloses adding “the software application to the electronic store (step 122) to allow users 30 to download the software application to a user computer (step 126). After downloading and installing the application, user 30 has the option of obtaining a license for the application,” paragraph 0054. Thus, it appears that Biddle first downloads the program module (software) and then a license module whereas claim 10 recites “said distribution of one said program module is responsive to the prior execution of said licensing module on one said customer terminal computer.” Because the downloading of the identified elements of Biddle is in the opposite order to that recited in claim 10, it is submitted that the rejection has been overcome. Thus, it is submitted that claim 10 as amended is allowable over the cited prior art.

Claims 11 and 12 are amended to remove “means” language as in claim 10. Claims 11 and 12 are submitted to be allowable at least as depending from an allowable base claim. Claims 13 and 14 are canceled.

Claims 15-17 are submitted to be allowable at least as depending from an allowable base claim. Claim 15 is amended to depend from claim 10 and to replace “means” by “device” as in claim 10. Claim 15 recites, “said distribution of one said program module commences automatically in response to user input to said executed licensing module.” This claim element does not appear to be shown by Biddle. In particular, Biddle does not appear to show user input to an executed licensing module. Biddle does not appear to disclose that the licensing module is separately executed or that it accepts user input. Therefore, claim 15 is submitted to be additionally allowable.

Claim 16 recites, “said program module executes in said licensed or unlicensed condition responsive to output from said licensing module.” Biddle does not appear to show this limitation because Biddle does not appear to show a program module that is responsive to output from a licensing module. Therefore, claim 16 is submitted to be additionally allowable.

Claim 18 is amended to clarify the limitations regarding the “program module” and the software distribution points. Claim 18 as amended recites, “the program module consisting of a portion of the software product that is not customized for the distributor or group of distributors, the program module comprising executable software code.” Biddle

does not appear to show these features. In particular, the element of Biddle cited in the phone interview of November 2, 2004 as corresponding to the program module, the “license” of paragraph 0054 of Biddle, does not appear to be disclosed as “comprising executable software code.” It appears that the user “obtains” a license, but the portions of Biddle cited in the Office Action (paragraphs 0055, 0058, 0059, 0062, 0065 and 0066) do not appear to disclose what type of license is obtained or whether it contains executable software code. Because the cited elements do not appear to show all the limitations of claim 18, it is submitted that claim 18 as amended is allowable over the cited portions of Biddle.

In addition, claim 18 as amended recites, “storing the configured licensing module at a first software distribution point so that it may be downloaded by a user, and storing the program module at a location other than the first software distribution point.” These features do not appear to be shown in the cited portions of Biddle and the Office Action did not indicate which features of Biddle correspond to the claim elements. Biddle states in cited paragraph 0055, “In an alternative exemplary embodiment, a vendor purchases a software licensing system (SLS).” However, it is not clear where the “software application” is stored in this example. In particular, Biddle does not appear to disclose storing the “software application” at some point other than the vendor’s distribution point. It appears that this may be an example of a vendor assuming the role of distributor, “by purchasing a licensing system from a distributor 25 and carrying out the function of distributing software products directly to the user rather than giving the software product back to the distributor for distribution,” paragraph 0053. Thus, in this scenario it appears that the vendor may become his own distributor storing software and managing licensing. In such an example the software application and license are obtained from the same location. Thus, there appears to be no storage at a location “other than the first software distribution point” of claim 18. Because this limitation has not been identified in the prior art, it is submitted that claim 18 is allowable.

Claims 19-26 are submitted to be allowable as depending from an allowable base claim. In addition, claim 22 recites, “updating the software product by modifying the program module but not modifying the licensing module.” The “license” of Biddle was identified as corresponding to the program module of claim 18 and the “software

application” was identified as corresponding to the licensing module of claim 18. However, Biddle does not appear to disclose updating the software product by modifying the license but not modifying the software application. No features of Biddle were identified as showing these claim elements. Therefore, it is requested that such features be identified or that the rejection be withdrawn.

New claim 26 is added. Claim 26 is believed to be supported throughout the specification and in particular at page 11, line 2. Claim 26 recites, “the program module is larger than the licensing module.” Biddle does not appear to show this feature. In particular, Biddle does not appear to indicate that the “license” is larger than the “software application.” Therefore, this claim is submitted to be allowable.

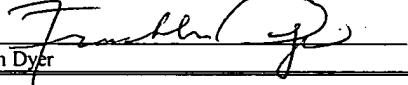
Finality of Rejection

The Office Action indicated that the rejection of all claims was final (Supplemental Office Action Summary, Status 2a). No additional explanation for the finality of the rejection was provided and PAIR describes the Office Action as “non-final.” Thus, it is believed that the indication of finality was in error. It is submitted that a final rejection was not appropriate because the Examiner introduced new grounds for rejecting claims 1-5. “Second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement,” MPEP 706.07(a). Therefore, if the rejection is considered final, it is submitted to be premature (MPEP 706(c)) and it is requested that the finality be withdrawn in accordance with MPEP 706.07(d).

Accordingly, it is believed that the present application is now in condition for allowance and an early indication of its allowance is solicited. However, if the Examiner is aware of any further matters that require attention, a telephone call to the undersigned attorney at (415) 318-1160 would be appreciated.

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Franklin Dyer

Respectfully submitted,



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12/2/04
Date